

Docket TRAC-100FWC CON

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Rhonda Tracy

Serial No.: 09/107,643

Filed: June 30, 1998

For: Disposable Diaper With Padded  
Waistband And Padded Legholes

Examiner: R. Clarke

Art Unit: 3761

Assistant Commissioner for Patents  
Washington, D. C. 20231

Sir:



I hereby certify that this correspondence  
is being deposited with the United States  
Postal Service as first class mail in an  
envelope addressed to: Assistant  
Commissioner for Patents, Washington,  
D.C. 20231, on May 4, 1999

*Rhonda Tracy*

Date May 4, 1999

RECEIVED April 23, 1999

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Group 3700

TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION

I, Edward D. Manzo, represent that I am the attorney of record for this application and U.S. Patent No. 5,064,421. Rhonda Tracy is the inventor and owner of both the application and the patent.

The terminal part of any patent granted on the above-identified application 09/107,643 which would extend beyond the expiration date of common-owned U.S. Patent No. 5,064,421 is hereby disclaimed, and it is agreed that any patent so granted on U.S. Application Serial No. 09/107,643 shall be enforceable only for and during such period that the legal titleholder to said patent shall be the same as the legal titleholder to U.S. Patent No. 5,064,421, this agreement to run with any patent granted on the above-identified U.S. Application Serial No. 09/107,643 and to be binding upon the grantee, its successors and assigns.

05/10/1999 SARAYA 00000166 09107643

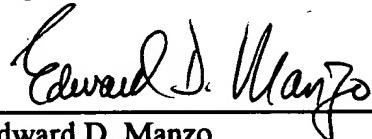
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In making the above disclaimer, disclaimant does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of U.S. Patent No. 5,064,421 in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued in any manner or is terminated prior to expiration of its full statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

Enclosed is a check in the sum of \$55.00 for the fee for this terminal disclaimer. If any further fee should be due, please charge our deposit account 03-3135.

Respectfully submitted,



Edward D. Manzo  
Attorney of Record  
Registration No. 28,139

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200 West Adams Street, Ste. 2850  
Chicago, Illinois 60606  
312-236-8500



GRAN37618

Attorney docket TRAC-100 FWC.CON

JK  
5/4/99

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Rhonda Tracy  
Serial No.: 09/107,643  
Filed: June 30, 1998  
For: *Disposable diaper with padded waistband and padded legholes*  
Examiner: R. Clarke  
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**Submission of Terminal Disclaimer and Response**

In the Notice To Applicant, paper no. 8 mailed April 7, 1999, Applicant was given one month or to the end of the term set in the prior Office Action to respond. This is Applicant's response.

**Terminal Disclaimer Herewith**

Applicant respectfully traverses the Examiner's averment that the amendment filed January 29, 1999 was incomplete. Applicant respectfully asserts that an *offer* to submit a terminal disclaimer after claims are indicated to be otherwise allowable (as was done in the January 1999 amendment) has sufficed for decades in other PTO examining groups to meet an objection to double patenting, obviousness type. Nevertheless, in a spirit of cooperation and desire to move this case forward, Applicant herewith submits a Terminal Disclaimer with the requisite fee. This should overcome any perceived deficiency by the PTO.

**Summary of Status**

In the January 1999 Amendment, Applicant submitted three additional claims, argued that the art rejection based on Foreman, of record, was insufficient on its merits to reject the application, and tendered a Declaration of Rhonda Tracy (Applicant) to overcome the date of the applied art.

Applicant believes that the Office Action is fully responded to, and Applicant awaits any further PTO response. Applicant assumes that since no comment was offered by the PTO on the art used to support the art rejection of the prior Office Action, the PTO has accepted the argument and/or declaration of prior invention.

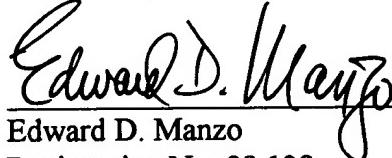
Art Remaining To Be Considered

Applicant notes that she submitted further publications in March 1999 and requests confirmation that the Examiner has considered them. This art was received just shortly before the March 1999 submission and was until then unknown to Applicant. In connection with the January 1999 declaration already of record, Applicant asserted an actual reduction to practice by October 3, 1986. These dates are earlier than the October 9, 1986 date of the EPO citation included in the Information Disclosure Statement which the PTO Mail Room received on March 22, 1999. Applicant submits that the application should now be allowed.

No Further Fee Required; Conditional Request for Time Extension

If any further fee is required, it may be charged to deposit account 03-3135. Applicant is responding within 30 days of the April 7, 1999 notice and thus does not believe that any extension of time is required. Nor did the Notice indicate that any time extension would be necessary. However, if the PTO considers that an extension is needed, Applicant hereby requests a time extension sufficient to permit entry of the response.

Respectfully submitted,

  
Edward D. Manzo  
Registration No. 28,139  
Attorney for Applicant

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Chicago, IL 60606  
312-236-8500

enclosure (Terminal Disclaimer & fee)